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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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William J. Baer

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EDELL, SHAPIRO, & FINNAN, LLC

1901 RESEARCH BOULEVARD, SUITE 400

ROCKVILLE, MD 20850

EXAMINER

BASEHOAR, ADAM L

ART UNIT

PAPER NUMBER

2178

NOTIFICATION DATE

DELIVERY MODE

02/25/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

epatent@usiplaw.com

<i>Office Action Summary</i>	Application No.	Applicant(s)	
	09/489,143	BAER ET AL.	
	Examiner	Art Unit	
	ADAM L. BASEHOAR	2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 06 August 2008.  
2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-24 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>08/06/08 &amp; 12/24/08</u> .                                 | 6) <input type="checkbox"/> Other: _____                          |

### DETAILED ACTION

1. This action is responsive to communications: The Amendment filed 08/06/08.
2. All previous rejections to the claims have been withdrawn as necessitated by Amendment.
3. Claims 1-24 pending. Claims 1, 9, and 17 are independent.

### *Information Disclosure Statement*

4. The information disclosure statements (IDS) submitted on 08/06/08 and 12/24/08 have been considered by the examiner.

### *Claim Rejections - 35 USC § 103*

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-6, 9-14, 17-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yonezawa et al. (hereinafter Yonezawa), U.S. Patent No. 5,905,973 filed 9/29/1997, issued 5/18/1999, in view of Farrell (US-5,383,129), and further in view of Dedrick (hereinafter Dedrick), US 5,768,521 patented 6/16/1998.

In regard to independent claim 1, Yonezawa teaches an online shopping System utilizing an electronic shopping basket titled "Contents of shopping basket", which can be fairly interpreted

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as a content object (claim 1 "a content object"), the contents of said basket showing a plurality of selected flower items (claim 1 "a plurality of content entities"), said basket also showing total payment for the items in said basket (claim 1 "a price for the content object") (Yonezawa Abstract, Figure 4). It is noted that Yonezawa's total payment indicated in Figure 4 results from the multiplication of sub-item numbers (Figure 4 item 408) with unit prices (Figure 4 item 406), resulting in sub-totals added accordingly (Figure 4 item 410).

Yonezawa does not forcefully disclose that its shopping basket is a "collection of images". However, Yonezawa's teaching of a flower catalog including two images of flower bunches within said flower catalog (Yonezawa Figure 3) providing reasonable suggestion to one of ordinary skill in the art at the time of the invention that Yonezawa's shopping basket (content object) is at least associated with, and reflective of, a collection of flower images ("collection of images") for sale, providing the benefit of image collections to aid the user selection process.

Yonezawa does not specifically disclose that the price (Yonezawa's total payment) is determined from a "content count". However, Yonezawa's teaches in column 5 lines 23-25 that numeral 412 (total payment) "denotes a total pay amount for all items", providing reasonable suggestion to one of ordinary skill in the art at the time of the invention that Yonezawa's "all items" (corresponding to claim 1 "content count") is used by Yonezawa to determine (via the processing of sub-item numbers with unit pricing in Yonezawa Figure 4) to achieve a total payment price for the content object. It is further noted that Yonezawa Figure 4 item 408 reflects sub-item numbers, which when added together form a total count of all items selected. Displaying the shopping basket with processed sub-item numbers, unit pricing, sub-totals, and total payment, provides the user the benefit of visually checking a purchase accordingly.

Yonezawa teaches wherein the total price for producing the content object relied on the actual count of the type and number of content entities included in the content object (Fig. 4: 408: "Number"). Yonezawa does not specifically teach determining a price for the content object to be produced based upon generating an estimated content count that represents an estimated quantity of content within the content object, wherein the digital data within the selected content entities are utilized to determine the estimated content count in response to a first set of conditions. Farrell teaches that based on a first set of conditions (Fig. 10: 508 & 510) determining a price (Fig. 11: 522: "determine total PM cost for job") for the content object to be produced (Abstract: "cost of printing materials used to print a job") based upon generating an estimated content count that represents an estimated quantity of content within the content object, wherein the digital data within the selected content entities are utilized to determine the estimated content count (column 7, lines 46-67; column 8, lines 1-50: "counter established for each unique printing materials type to be used in the print job...production of output usable to the customer...assumed that the expected number of sets will be produced and an estimate is produced...unit cost of each printing material type...stored in a database...look-up table...expressed as a multiple reference value")(Figs. 10 & 11: 510: "For each PM item count the expected quantity required to produce the expected number of sets", 518, 520, 522). It would have been obvious to one of ordinary skill in the art the time of the invention for the system of Yonezawa to have included the estimated content count/price feature of Farrell, because Farrell taught that by determining an estimated content count and subsequent estimated price of a specific content entity the user would be provided the benefit of making an informed decision about the cost of said entity, especially when the user had limited resources and the

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materials/cost to create the content entity were relatively great (column 9, lines 29-37: "such estimate is particularly useful"; column 8, lines 10-37: i.e. user can get a price estimate before/without actually having to produce the content entity).

Yonezawa does not specifically teach a digital object comprising digital data, and gathering counts from said digital data. However, Dedrick teaches a method of metering the flow of electronic information to a client computer (Dedrick Abstract). Dedrick teaches determining a unit of information count for the content entity (a digital entry) in col. 1 line 62 - col. 2 line 22, col. 3 lines 60-63, col. 4 line 26 - Col. 5 line 25, and col. 7 lines 29-43. Dedrick teaches specific examples that the content count unit may be in bytes or words in col. 4 lines 63-64. It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Dedrick to Yonezawa, providing Yonezawa the benefit of applying metering to virtual objects such as online books, digital directories etc.

In regard to dependent claim 2, Yonezawa teaches determining a number (content count) for each item type (Yonezawa Figure 4), with numbers in item 408 reflecting the subtotals of the total content count for the shopping basket (see also Yonezawa's column 5 lines 23-25).

In regard to dependent claim 3, Yonezawa teaches determining a number (content count) for each item type (Yonezawa Figure 4). Yonezawa does not specifically teach character counts for the entities. However, Dedrick teaches determining a unit of information count for the content entity in col. 1 line 62 - col. 2 line 22, col. 3 lines 60-63, col. 4 line 26 - col. 5 line 25, and col. 7 lines 29-43. Dedrick teaches specific examples that the content count unit may be in bytes or words in col. 4 lines 63-64. Although Dedrick does not specifically mention a character

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count, Dedrick's teaching of a byte unit count will correlate exactly in proportion to the size of the content entity just as a character count will correlate exactly in proportion to the size of the content entity. Each additional character contained in the content entity will increase the representative byte count by the same unit amount that a character count would increase. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have applied Dedrick's byte/character count to Yonezawa's shopping basket, providing Yonezawa the benefit of an alternative way of purchasing an item that is priced based upon character counts (i.e. custom greeting cards, embossing name plates, etc.).

Regarding dependent claim 4, Yonezawa teaches determining a number (content count) for each item type (Yonezawa Figure 4). Yonezawa does not specifically teach determining page counts from character counts for the entities. However, Dedrick teaches determining a unit of information count for the content entity in col. 1 line 62 - col. 2 line 22, col. 3 lines 60-63, col. 4 line 26 - col. 5 line 25, and col. 7 lines 29-43. Dedrick teaches specific examples that the content count unit may be in bytes or words in col. 4 lines 63-64. Determining a page count from the character count is merely changing the units of the count from characters to pages. Dedrick teaches an information unit count of bytes in col. 4 lines 63-64 and megabytes in col. 5 lines 21-23. The two example units of Dedrick are related exactly as the characters and pages of the claimed invention. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have applied Dedrick to Yonezawa, providing Yonezawa the benefit of converting characters into pages so that the cost computation would have been

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simplified.

In regard to dependent claim 5, Yonezawa teaches determining a number (content count) for each item type (Yonezawa Figure 4). Yonezawa also teaches determining content entity type (Yonezawa Figure 4 item 402, 404). Yonezawa does not specifically teach counting characters, and averaging from the entity. However, Dedrick teaches determining a unit of information count for the content entity in col. 1 line 62 - col. 2 line 22, col. 3 lines 60-63, col. 4 line 26 - col. 5 line 25, and col. 7 lines 29-43. Dedrick teaches specific examples that the content count unit may be in bytes or words in col. 4 lines 63-64. Although Dedrick does not specifically mention that the unit of information is a character count. However, Dedrick's teaching of a byte unit count will correlate exactly in proportion to the size of the content entity just as a character count will correlate exactly in proportion to the size of the content entity. Each additional character contained in the content entity will increase the representative byte count by the same unit amount that a character count would increase. Dedrick teaches counting the number of bytes in a content entity, and determining an average character count for content entities of that type in col. 1 line 62 - col. 2 line 22, col. 3 lines 60-63, col. col. 4 line 26 - col. 5 line 25, and col. 7 lines 29-43. It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Dedrick to Yonezawa, providing Yonezawa the benefit of displaying extra information for a more informed decision.

In regard to dependent claim 6, Yonezawa teaches determining a number (content count) for each item type (Yonezawa Figure 4). Yonezawa also teaches determining content



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entity type (Yonezawa Figure 4 item 402, 404), as well as a unit price (price per item) (Yonezawa Figure 4 item 406). Yonezawa does not specifically teach multiplying page counts. However, Dedrick teaches determining a unit of information count for the content entity in col. 1 line 62 - col. 2 line 22, col. 3 lines 60-63, col. col. 4 line 26 - col. 5 line 25, and col. 7 lines 29-43. Dedrick teaches multiplying the page count with a predetermined price per page in col. 1 line 62 - col. 2 line 22, col. 3 lines 60-63, col. col. 4 line 26 - col. 5 line 25, and col. 7 lines 29-43. It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Dedrick to Yonezawa, providing Yonezawa the benefit of displaying page counts within the shopping basket for a more informed decision, based upon items that are priced according to page counts.

In regard to claims 9, 10, claims 9, 10 reflect the computer program product comprising computer executable instructions used for performing the methods as claimed in claims 1, 2 respectively, and are rejected along the same rationale.

In regard to dependent claims 11-14, claims 11-14 reflect the computer program product comprising computer executable instructions used for performing the methods as claimed in claims 3-6 respectively, and are rejected along the same rationale.

In regard to claims 17, 18, claims 17, 18 reflect the system comprising computer executable instructions used for performing the methods as claimed in claims 1, 2 respectively, and are rejected along the same rationale.

In regard to claims 19-22, claims 19-22 reflect the system comprising computer executable instructions used for performing the methods as claimed in claims 3-6 respectively, and are rejected along the same rationale.

7. Claims 7-8, 15-16, and 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yonezawa, Farrell, and Dedrick as applied to claims 1, 9, 17 above, and further in view of Khan et al. (hereinafter Khan), US 6,199,054 B1 filed 3/5/1998.

Regarding dependent claim 7, Yonezawa does not teach that at least one of the content entities comprises user provided content. However, Khan teaches wherein a user may selectively add a user-provided content entity subject to price metering in col. 3 lines 61-64. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the user-provided content teaching of Khan to Yonezawa. It would have been obvious and desirable to have allowed the user to have provided content to further customize the interactive selection of content entities composing the content object, and displayed in Yonezawa's shopping basket.

Regarding dependent claim 8, Yonezawa does not specifically teach defining a price when exceeding predefined content maximum, etc. However, Dedrick teaches wherein the price for user-provided material is determined in a first manner if the content count exceeds a predetermined content count maximum, and is determined in a second manner if the content count does not exceed the predefined maximum in col. 5 lines 23- 25. It would have been

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obvious to one of ordinary skill in the art at the time of the invention to apply Dedrick to Yonezawa, providing Yonezawa the benefit of a more detailed price analysis added to Yonezawa's shopping basket.

In regard to dependent claim 15, claim 15 reflects the computer program product comprising computer executable instructions used for performing the method as claimed in claim 7, and is rejected along the same rationale.

In regard to dependent claim 16, claim 16 reflects the computer program product comprising computer executable instructions used for performing the method as claimed in claim 8, and is rejected along the same rationale.

In regard to dependent claim 23, claim 23 reflects the system comprising computer executable instructions used for performing the method as claimed in claim 7, and is rejected along the same rationale.

In regard to dependent claim 24, claim 24 reflects the system comprising computer executable instructions used for performing the method as claimed in claim 8, and is rejected along the same rationale.

*Response to Arguments*

8. Applicant's arguments with respect to claims 1, 9, and 17 have been considered but are moot in view of the new ground(s) of rejection.

*Conclusion*

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Please note the additionally cited references on the accompanying PTO-892 Form.

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11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ADAM L. BASEHOAR whose telephone number is (571)272-4121. The examiner can normally be reached on M-F: 8:00am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Adam L Basehoar/  
Primary Examiner, Art Unit 2178